In the Drawings:

A proposed change to Figure 11 of the drawings is attached.

REMARKS

The Applicants respectfully request the Examiner's approval of the proposed change to Figure 11 of the drawings attached as Appendix A. In the drawings previously submitted, due to apparent fading during photocopying, reference numeral 138 appeared to look like "133." This is corrected in the attached change. Replacement formal drawings are also being simultaneously herewith.

In response to the Office Action dated September 14, 2006, the Applicants respectfully submit the following amendments and remarks.

In paragraph 1 of the Office Action, the Examiner requested filing of a certified copy of the priority application, Israeli Patent Application 113723. In response, the Applicants respectfully point out that a certified copy of Israeli Patent Application 113723 was filed in U.S. Patent Application 08/623,238, to which this application claims priority. In particular, a certified copy of Israeli Patent Application 113723 was filed in U.S. Patent Application 08/623,238 on June 27, 1996, and was acknowledged in an Office Action dated December 2, 1996. See MPEP 201.14(b)(II) ("Where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) or in a reissue application and a certified copy of the foreign application as filed, has been filed in a parent or related application, it is not necessary to file an additional certified copy in the later application.")

In paragraph 2 of the Office Action, the Examiner objected to the drawings. The attached drawing change is made in response. In addition, the Applicants respectfully point out that reference numeral 28 is mentioned in the specification in paragraph 35 ("a portion 28 of the conjunctiva 18 which normally covers the intended implantation site").

In paragraph 3 of the Office Action, the Examiner objected to the Abstract due to its length. In the above amendments, the Abstract is shortened.

In paragraph 4 of the Office Action, the Examiner indicated that the claim to foreign priority should be inserted into the beginning of the disclosure. Applicants note that the claim to priority was included in the declaration, which appears to be all that is necessary. See MPEP 201.13(II)(A). If amendment to the specification is required, Applicants authorize amendment of the specification to state: "Priority is claimed to Israeli Patent Application 113723, filed May 14, 1995."

In response to paragraph 5 of the Office Action, Applicants have amended the specification to identify the sclera consistently with the reference numeral 12.

In paragraphs 6-15 of the Office Action, the claims were rejected as unpatentable over the prior art, including U.S. Patent No. 4,968,296 to Ritch ("Ritch") and U.S. Patent No. 3,788,327 to Donowitz ("Donowitz").

As an initial matter, the Applicants respectfully point out that the claims in this application have similarities with those that were at issue, and ultimately allowed, in U.S. Patent Application No. 09/383,472, now U.S. Patent No. 6,468,283. In that prior application, in an Office Action dated October 1, 2001, the PTO had rejected a number of the claims as being unpatentable over a combination of the Ritch and Donowitz references. In an Amendment dated January 31, 2002, the Applicants submitted arguments against the proposed combination of the Ritch and Donowitz references and reasons why the claims were novel and nonbvious over those references. Some of those arguments are repeated in large part below. In response to those arguments, Primary Examiner David Reip allowed the claims in that prior application.

With respect to the current claim rejections, the Applicants respectfully submit the following remarks.

Claims 32 and 33 were rejected under 35 USC 102(b) as being anticipated by Ritch. Claim 32 recites an intraocular implant comprising "a flange connected to the tube at the outlet end of the tube" (emphasis added). Claim 32 also recites a delivery device comprising "an abutment surface for abutting the flange of the implant." Accordingly, the abutment surface of the delivery device must abut the outlet end of the implant.

The Ritch reference describes implantation of a resilient "dumbbell" shaped implant 21. A special implantation instrument 16 houses the implant 21 for implantation. The Ritch patent describes and illustrates a method in which an incision 15 is made in the cornea opposite, i.e., across the anterior chamber from, the intended implantation site. (See Ritch col. 4, lines 58-51, and Fig. 3). The implantation instrument 16 is then advanced through the incision 15, across the anterior chamber of the eye, and then into the underside of the sclera at the intended implantation site. (See Ritch col. 4, lines 52-65). After the cannula 17 of the implantation instrument 16 has been inserted through the sclera, the resilient "dumbbell" shaped implant 21 is discharged from the implantation instrument 16. Because Ritch implants the device from the underside of the sclera, the outlet end of the implant comes out of the cannula first, followed by the inlet end.

In addressing claim 32, the Office Action states that Ritch discloses "an abutment surface (29) for abutting the flange (25) of the implant (21)." (Office Action, page 4). The Applicants respectfully submit that the flange (25) that abuts the surface (29) of Ritch is at the inlet end of the Ritch implant. By contrast, claim 32 requires that the flange that abuts the abutment surface of the delivery device be "at the outlet end of the tube." Accordingly, the Applicants respectfully submit that claim 32 is not anticipated by Ritch.

Claims 34-43 were rejected under 35 USC 103 as being anticipated by Ritch in view of Donowitz.

The Donowitz patent is discussed in the Background section of the Specification of this Application. The Donowitz patent proposes utilization of an intraocular implant with a valve mechanism in a tube for controlling flow out of the eye.

In the Amendment dated January 31, 2002, in U.S. Patent Application No. 09/383,472, the Applicants stated the following with respect to a proposed combination of Ritch and Donowitz:

> The Applicants respectfully submit that the Donowitz [implant] could not be implanted according to the Ritch method without substantial modification not suggested by the references. For example, the Donowitz implant has a slanted or pointed end face 38 at the end of the shank 28 to facilitate implantation. In the Ritch method, however, the implant is inserted from the underside of the sclera, i.e., from the inside of the eye toward the outside. Thus, if one tried to implant the Donowitz device by the Ritch method, the slanted or pointed end face 38 would be sticking out of the eye, which would be undesirable. This slanted or pointed end face 38 would presumably need to be removed. Moreover, the Donowitz device apparently would need to be modified to be accommodated within the implantation instrument 16 as described in the Ritch reference. No such modification is suggested by the references. Accordingly, the Applicants respectfully submit that it would not have been obvious to implant the Donowitz implant using the Ritch method.

(Amendment dated January 31, 2002, in U.S. Patent Application No. 09/383,472).

In response to these earlier arguments, Primary Examiner Reip allowed the claims in that application. The Applicants respectfully submit that Examiner Reip's acceptance of the arguments against the combination of Ritch and Donowitz should be given full faith and credit. MPEP 706.04.

Moreover, even if the Donowitz implant could be implanted using the Ritch method, it would not meet the limitations of the Applicants' claims, for the following reasons.

As described above, claim 32 requires that the flange that abuts the abutment surface of the delivery device be "at the outlet end of the tube." Neither Ritch nor Donowitz discloses such a feature.

Claim 34 requires that "the tube has a pointed tip at the inlet end of the tube" (emphasis added). The Office Action states that it would have been obvious to provide the implant of Ritch with the pointed tip of Donowitz "in order to facilitate easy insertion into any portion of the eye desired, without the use of a separate piercing device." (Office Action, page 7). Even if that were true, this would result in putting the pointed tip on the outlet end of the Ritch implant, because the Ritch implant is inserted from the underside of the sclera, i.e., from the inside of the eye toward the outside. Accordingly, the proposed combination would not meet the claim limitation requiring that "the tube has a pointed tip at the inlet end of the tube."

Claim 39 requires that "the tube has at least one side opening at the inlet end for allowing flow of aqueous humor into the tube passage." The Office Action states that "to construct the implant of Ritch et al. with side openings that may be used as markers as taught by Wong et al. [U.S. Patent No. 5,000,731] would have been obvious to one of ordinary skill in the art at the time the invention was made in order to further facilitate aqueous humor drainage." (Office Action, page 10). In Ritch, however, the entire length of the tube, i.e., the length between the two flanges 24, 25, is completely within the sclera. As such, there is no point in putting an opening in the side of the Ritch tube, and it would not work. It could not serve as a marker, because it is hidden by the sclera, and it could not serve for drainage, because it is covered by the

sclera. Moreover, there is no suggestion for changing the Ritch device to project into our out of the sclera to accommodate a side opening.

Thus, for the foregoing reasons, the Applicants respectfully request reconsideration of the rejections of the pending claims. Should any questions arise concerning this application, the Examiner is invited to contact the undersigned at (202) 220-4200. The Commissioner is authorized to charge any necessary fees or credit any overpayments under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON LLP

Dated: Dec. 11, 2006 By: 

Douglas E. Ringel
(Reg. No. 34,416)

1500 K Street NW
Washington, DC 20005
(202) 220-4200

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Annotated Sheet

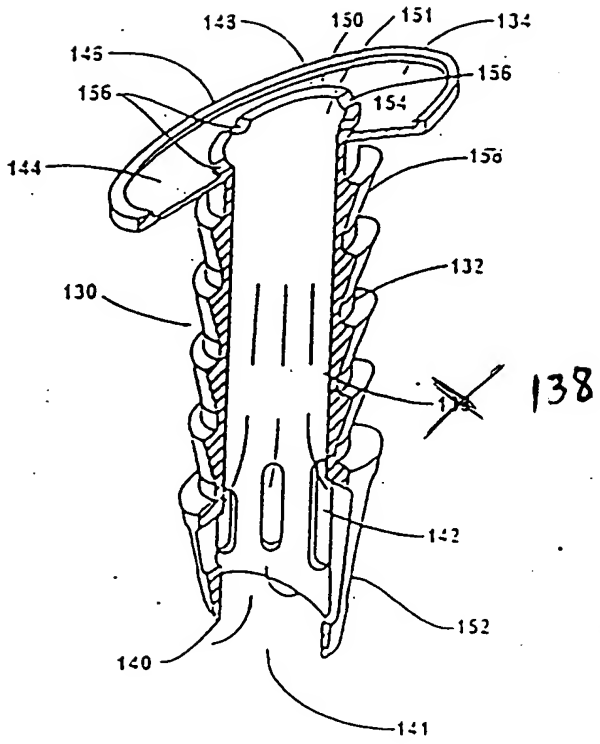

FIG. 11

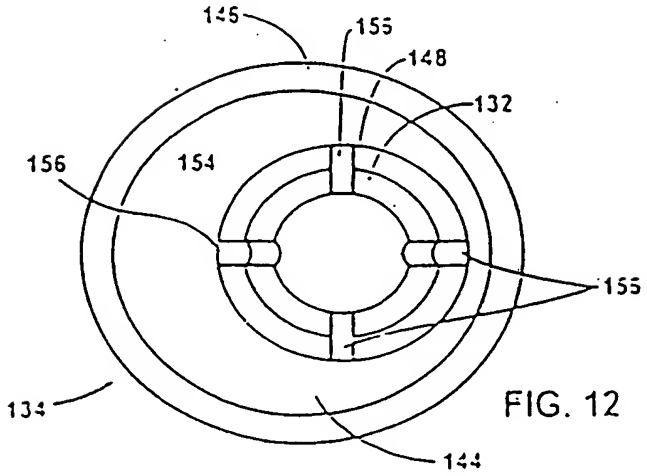

FIG. 12